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Trademark Law

February 27, 2007

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Re: **Application Serial No.:** 09/966,909  
**Appellants:** Jay Paul Drummond, et al.  
**Filing Date:** September 27, 2001  
**Confirmation No.:** 5701  
**Title:** AUTOMATED BANKING MACHINE  
SYSTEM AND METHOD  
**Docket No.:** D-1147 R1

Sir:

Please find enclosed the second Supplemental Appeal Brief of Appellants pursuant to 37 C.F.R. § 41.37. This Brief corrects the "Evidence Appendix" as required in the Office Communication dated February 5, 2007.

A fee (\$500) has already been paid for a previously filed Appeal Brief. However, if any fees are due, please charge Deposit Account 09-0428 of Diebold Self-Service Systems.

Very truly yours,

Ralph E. Jocke  
Reg. No. 31,029

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D-1147 R1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:	)	
<b>Jay Paul Drummond, et al.</b>	)	
	)	Art Unit 3624
Serial No.: <b>09/966,909</b>	)	
	)	
Confirm. No.: <b>5701</b>	)	
	)	
Filed: <b>September 27, 2001</b>	)	Patent Examiner
	)	Alain L. Bashore
For: <b>AUTOMATED BANKING</b>	)	
<b>MACHINE SYSTEM AND</b>	)	
<b>METHOD</b>	)	

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
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**BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 41.37**

Sir:

The Appellants hereby submit their second Supplemental Appeal Brief pursuant to 37 C.F.R. § 41.37 concerning the above-referenced Application. This Brief corrects the "Evidence Appendix" as required in the Office Communication dated February 5, 2007.

**(i)**

**REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is  
Diebold, Incorporated, an Ohio corporation.

(ii)

**RELATED APPEALS AND INTERFERENCES**

Appellants believe that there are no related appeals or interferences pertaining to this matter.

(iii)

## STATUS OF CLAIMS

Claims 1-20 are pending in the Application.

Claims rejected: 1-20

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claims objected to: none

Claims canceled: none

Appellants appeal the rejections of claims 1-20. These claim rejections were the only claim rejections present in the Office Action ("Action") dated June 7, 2006, which re-opened prosecution after Appellants' first appeal to the Board. Claims 1-20 have been at least twice rejected.

**(iv)**

**STATUS OF AMENDMENTS**

A non-final rejection was made June 7, 2006. No amendments to the claims were requested to be admitted after the non-final rejection.

**(v) SUMMARY OF CLAIMED SUBJECT MATTER**

*Concise explanations of exemplary forms of the claimed invention:*

**With respect to independent claim 1**

An exemplary form of the invention is related to automated banking machines such as automated teller machines (ATMs). This described exemplary form of the invention is directed to a method which comprises receiving with an automated banking machine (82) (Figure 4) at least one first wireless communication signal from a portable wireless device (Page 11, lines 10-16). Examples of such portable wireless devices discussed in the Specification include notebook computers (86), personal digital assistants (PDAs) and mobile phones (90) (Page 11, lines 16-17). The exemplary form of the method further comprises sending through operation of the banking machine at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server in operative connection with the banking machine through a wide area network (Page 12, lines 3-6). An example of a public wide area network described in the Specification includes the Internet (94). The exemplary form of the method further comprises receiving through operation of the banking machine at least one second network communication signal from the at least one server and sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device corresponding to the at least one second network communication signal (Figures 4 and 5; Page 5, lines 1-14; Page 12, line 3 to page 15, line 21).

**With respect to independent claim 6**

Another exemplary form of the invention is directed to computer readable media bearing instructions which are operative in at least one computer of an automated banking machine (82) to cause the automated banking machine to carry out a method. In this described exemplary form of the invention, the method comprises receiving with an automated banking machine (82) (Figure 4) at least one first wireless communication signal from a portable wireless device (Page 11, lines 10-16). Examples of such portable wireless devices discussed in the Specification include notebook computers (86), personal digital assistants (PDAs) and mobile phones (90) (Page 11, lines 16-17). The exemplary form of the method further comprises sending through operation of the banking machine at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server in operative connection with the banking machine through a wide area network (Page 12, lines 3-6). An example of a public wide area network described in the Specification includes the Internet (94). The exemplary form of the method further comprises receiving through operation of the banking machine at least one second network communication signal from the at least one server and sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device corresponding to the at least one second network communication signal (Figures 4 and 5; Page 5, lines 1-14; Page 12, line 3 to page 15, line 21).

**With respect to independent claim 7**

Another exemplary form of the invention is directed to an apparatus (80) which comprises an automated banking machine (10, 82) including a computer (Figures 1 and 4). At



least one transaction function device (102) is in the machine and in operative connection with the computer. Examples of transaction function devices discussed in the Specification include a sheet or cash dispenser (20), depositor (22), receipt printer (24), and card reader (26) (Page 9, lines 15-19). The apparatus further comprises an external network interface (92) in operative connection with the computer. Examples of an external network interface described in the Specification include a high speed network connection such as ISDN, ADSL, DSL, Cable Modem, T1, Fractional T1, or Frame Relay (Page 12, lines 5-6). The external network interface enables the machine to communicate in a wide area network (94). An example of a public wide area network discussed in the Specification includes the Internet (94) (Page 12, line 4). In this described exemplary form of the invention, the apparatus also includes a wireless access hub (84) in operative connection with the computer. The wireless hub enables the machine to communicate with at least one portable wireless device (Page 11, lines 14-16). Examples of portable wireless devices discussed in the Specification include notebook computers (86), personal digital assistants (PDAs) and mobile phones (90) (Page 11, lines 16-17). The machine is operative to enable the at least one portable wireless device to communicate in the wide area network (Page 5, lines 1-6; Page 12, lines 3-4).

**With respect to independent claim 18**

Another exemplary form of the invention is related to automated banking machines such as automated teller machines (ATMs). This described exemplary form of the invention is directed to a method which comprises providing, with an automated banking machine (82), a wireless network connection (84) between a portable wireless device and the automated banking

machine (Figure 4, Page 11, lines 13-16). Examples of portable wireless devices discussed in the Specification include notebook computers (86), personal digital assistants (PDAs) and mobile phones (90) (Page 11, lines 16-17). Examples of wireless network devices, interfaces, and systems for providing a wireless network connection between the ATM and portable wireless devices include an IEEE 802.11b, Bluetooth™, and IR based systems (Page 11, line 18 to page 12, line 1). In this described exemplary form of the invention, the automated banking machine includes a cash dispenser (20) (Figure 1). In addition, the method comprises providing, with the automated banking machine, a network connection between the automated banking machine and a public wide area network (Page 12, lines 3-6). An example of a public wide area network described in the Specification includes the Internet (94). Examples of an external network interface (92) which provides the network connection to the public wide area network include a high speed network connection such as ISDN, ADSL, DSL, Cable Modem, T1, Fractional T1, or Frame Relay (Page 12, lines 5-6). The method further comprises determining with the automated banking machine that the portable wireless device is permitted to access the public wide area network (Page 12, line 9 to page 13, line 2). Responsive to this determination, the method comprises providing with the automated banking machine, the portable wireless device with access to the public wide area network through the wireless network connection with the automated banking machine (Page 5, lines 1-6).

**(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The grounds to be reviewed in this appeal are:

Whether Appellants' claim 17 is indefinite pursuant to 35 U.S.C. § 112, second paragraph;

Whether Appellants' claims 1, 4, 6 and 18 are unpatentable pursuant to 35 U.S.C. § 102(e) as being anticipated by Joao, et al., U.S. Publication No. US 2001/0051920 ("Joao");

Whether Appellants' claims 7, 11, and 16-17 are unpatentable pursuant to 35 U.S.C. § 103(a) over Joao in view of Stewart, et al., U.S. Patent No. 6,732,176 ("Stewart");

Whether Appellants' claims 5 and 13-15 are unpatentable pursuant to 35 U.S.C. § 103(a) over Joao in view of Bansal, et al., U.S. Patent No. 6,439,456 ("Bansal");

Whether Appellants' claims 2, 9-10, and 19-20 are unpatentable pursuant to 35 U.S.C. § 103(a) over Joao in view of Laybourn, et al., U.S. Patent No. 6,480,710 ("Laybourn");

Whether Appellants' claims 3, 8, 12 are unpatentable pursuant to 35 U.S.C. § 103(a) over Joao in view of Jones et al., U.S. Patent No. 5,905,810 ("Jones");

Whether Appellants' claims 1 and 18 are unpatentable on the ground of non-statutory obviousness-type double patenting over claims 1, 3, 5, 13-17, 18, 25-27 of Ramachandran, et al., U.S. Patent No. 6,702,181 ("the '181 patent");

Whether Appellants' claims 1, 6, and 18 are unpatentable on the ground of non-statutory obviousness-type double patenting over claims 1, 6, 15, 19, 20-21 of Drummond, et al., U.S. Patent No. 6,796,490 ("Drummond"); and

Whether Appellants' claims 1 and 18 are unpatentable on the ground of non-statutory obviousness-type double patenting over claims 1, 5, 15, 17, and 21 of Ramachandran, et al., U.S. Patent No. 7,040,533 ("the '533 patent").

(vii)

## **ARGUMENT**

### **Joao ( U.S. Publication No. US 2001/0051920 )**

Joao is directed to a system that automatically notifies users by telephone, pager, et cetera, that a transaction is being carried out with one of their accounts (e.g. credit card). The user may then authorize or cancel the transaction (Figures 3A-3C).

### **Stewart (U.S. Patent No. 6,732,176)**

Stewart is directed to a distributed network that includes wireless access points (120) (Figure 1; Column 2, lines 6-11).

### **Bansal (U.S. Patent No. 6,439,456)**

Bansal is directed to a method of transferring money from a cash card (102) inserted into a wireless phone (103) by making a telephone call using the phone (103) to another individual or entity. The information regarding the transfer can be transmitted from the user's wireless telephone using touch tones (Column 3, lines 33-41).

### **Jones (U.S. Patent No. 5,905,810)**

Jones is directed to a currency processing system that includes an ATM capable of dispensing cash (Column 2, lines 25-32).

**Laybourn (U.S. Patent No. 6,480,710 )**

Laybourn is directed to a system (a) for managing a wireless prepaid service which includes a combination of networked workstations and servers. The system is accessible via wireless devices (10) such as mobile phones, fixed phones or a communication network such as the Internet (Figure 1; Column 2, lines 27-46).

**The 35 U.S.C. § 112, second paragraph Rejection**

Claims 17 was rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particular point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

**Claim 17**

Claim 17 depends from claim 16 and recites that the wireless access hub enables RF communication over relatively short distance with the at least one portable wireless device.

The Action indicated that the recitation in claim 17 of “relatively short” is considered vague and indefinite. Appellants respectfully disagree.

The Specification discloses at page 11, line 20, to page 12, line 1, that “alternative exemplary embodiments of the system 80 may use any other wireless network interfaces and systems between the portable wireless devices and the ATM, including for example generally short range RF communication such as Bluetooth™ and IR based systems.” One skilled in the art would recognize that the recited feature of “RF communication over relatively short distances” corresponds to the distances associated with short range RF communications carried

out using Bluetooth™ RF communication systems for example. One skilled in the art would also recognize that the term “relatively” is with respect to other types of RF communication systems which allow communication over longer distances such as IEEE 802.11b compatible wireless network interface described at page 11, lines 18-20.

Thus claim 17 is not vague and indefinite in view of the Specification. It follows that the 35 U.S.C. § 112, second paragraph rejection of claim 17 should be reversed.

### **The 35 U.S.C. § 102 (e) Rejections**

#### **The Applicable Legal Standards**

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency, the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used

or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999). It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

### **Rejection under 35 U.S.C. § 102(e) over Joao**

Claims 1, 4, 6, and 18 were rejected under 35 U.S.C. § 102(e) as being anticipated by Joao. These rejections are respectfully traversed.

#### **Claim 1**

Claim 1 is an independent claim directed to a method. The method includes a step (a) of receiving with an automated banking machine at least one first wireless communication signal from a portable wireless device. The method also includes a step (b) of sending through operation of the banking machine at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server in operative connection with the banking machine through a wide area network. In addition, the method includes a step (c) of receiving through operation of the banking machine at least one second network communication signal from the at least one server. Further, the method includes a step (d) of sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device corresponding to the at least one second network communication signal.

The Action asserts that Joao discloses each of these steps. Appellants respectfully disagree. Joao is directed to a system that automatically notifies users by telephone, pager, etc.,



that a transaction is being carried out with one of their accounts (e.g. credit card). The user may then authorize or cancel the transaction (Figures 3A-3C). With respect to claim 1, the Action references Figure 10 and paragraphs [0257], [0246], [0259], and [0053] of Joao to support the rejections. However, neither these portions, nor any other portions of Joao, discloses or suggests all of the features relationships and steps recited in claim 1.

For example, Joao does not disclose or suggest steps (a) and (b) of Appellants' claim 1. In step (a) an automated banking machine receives at least one first wireless communication signal from a portable wireless device. In step (b) the automated banking machine sends at least one first network communication signal corresponding to the at least one first wireless communication signal received by the banking machine, to at least one server in operative connection with the banking machine through a wide area network.

These steps correspond to an automated banking machine such as an ATM that is capable of enabling wireless communication devices to access servers on the Internet through wireless communication with the ATM. Joao is not directed to such a system. Nowhere does Joao disclose or suggest an automated banking machine capable of carrying out recited steps (a) and (b) of claim 1.

For example, referenced paragraph [0257] of Joao indicates that a central processing computer (303) may be linked with various communication devices (e.g., phone 307, pager 313) through a wired or wireless link (Figure 10). Referenced paragraph [0246] indicates that Joao may include an electronic cash transaction device (302) which is a terminal or other device used by an operator in performing transactions involving electronic cash. Referenced paragraph [0259] refers to Figure 11, and lists the various devices that are a part of the electronic cash

transaction device (302) (e.g., CPU 302A, transmitter 302G, receiver 302H, etc.). Referenced paragraph [0053] indicates that Joao may be used in connection with the Internet.

These portions of Joao do not disclose or suggest an automated banking machine that is capable of carrying out steps (a) and (b) of claim 1. Further, the Action does not explain how these cited paragraphs correspond to the Appellants' recited steps. The Office apparently regards Joao's communication devices (e.g., phone 307, and pager 313) as corresponding to the recited "portable wireless device." However, the Action does not state which features of Joao allegedly correspond to Appellants' recited automated banking machine and recited server. Thus, Appellants have been forced to speculate that the Office regards the electronic cash transaction device (302) as corresponding to an automated banking machine, and regards the central processing computer (303) as corresponding to a server.

However, regardless of whether the communication device, the electronic cash transaction device, and the central precessing computer of Joao could correspond respectively to a portable wireless device, an automated banking machine, and a server, the referenced portions of Joao still do not disclose or suggest that the system of Joao carries out steps (a) and (b) as specifically recited in claim 1. Nowhere do the Action's referenced portions or any other portion of Joao, disclose or suggest that Joao's electronic cash transaction device (or any other device/terminal 2, 102, 202, etc.) both receives a wireless communication signal from a communication device (e.g., wireless phone, pager) and then operates to send a network communication signal corresponding to the wireless communication signal, to Joao's central processing computer.

In addition, recited steps (a) and (b) are also not inherent in Joao. Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is “necessarily present” in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999).

Whether or not Joao discloses a wide area network as discussed in the Action, neither a wide area network nor any other feature in Joao requires or necessitates an automated banking machine to send a network communication signal to a server through a wide area network, which signal corresponds to a wireless communication signal received with the automated banking machine from a portable wireless device. Nowhere does Joao require or necessitate a portable wireless device to communicate with an automated banking machine to facilitate communication over a wide area network. Thus the recited steps (a) and (b) of claim 1 are not inherent in Joao.

In addition, nowhere does Joao disclose or suggest an automated banking machine that sends to a server a network communication signal that corresponds to a wireless communication signal from a portable wireless device, and as recited in steps (b) and (c) sends at least one second wireless communication signal to the portable wireless device corresponding to at least one second network communication signal received from the server. Nowhere does Joao disclose or suggest an ATM that enables a wireless portable device to communicate wirelessly

with the ATM to facilitate two-way communication between the wireless portable device and a server on a wide area network.

Joao does not explicitly or inherently disclose or suggest each of the steps, features, and relationships recited in claim 1. Appellants respectfully submit that the 35 U.S.C. § 102(e) rejection of claim 1 should be reversed.

#### **Claim 4**

Claim 4 depends from claim 1 and recites that the portable wireless device comprises a voice communication device. Joao does not disclose or suggest an automated banking machine which receives a wireless communication signal from a portable wireless voice communication device. Further, Joao does not disclose or suggest sending through operation of the automated banking machine a wireless communication signal to the portable wireless voice communication device.

Joao does not anticipate claim 4. Appellants respectfully submit that the 35 U.S.C. § 102(e) rejection of claim 4 should be reversed.

#### **Claim 6**

Claim 6 is an independent claim directed to computer readable media bearing instructions which are operative in at least one computer to cause an automated banking machine to carry out a method that includes a step (a) of receiving with the automated banking machine at least one first wireless communication signal from a portable wireless device. The method also includes a step (b) of sending through operation of the banking machine at least one first network

communication signal corresponding to the at least one first wireless communication signal, to at least one server in operative connection with the banking machine through a wide area network. In addition, the method includes a step (c) of receiving through operation of the banking machine at least one second network communication signal from the at least one server. Further, the method includes a step (d) of sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device corresponding to the at least one second network communication signal.

The Action asserts that Joao discloses each of these steps. Appellants respectfully disagree. Joao is directed to a system that automatically notifies users by telephone, pager, etc., that a transaction is being carried out with one of their accounts (e.g., credit card). The user may then authorize or cancel the transaction (Figures 3A-3C). With respect to claim 6, the Action references Figure 10 and paragraphs [0257], [0246], [0259], and [0053] of Joao to support the rejections. However, neither these portions, nor any other portions of Joao, discloses or suggests all of the features relationships and steps recited in claim 6.

For example, Joao does not disclose or suggest steps (a) and (b) of Appellants' claim 6. In step (a) an automated banking machine receives at least one first wireless communication signal from a portable wireless device. In step (b) the automated banking machine sends at least one first network communication signal corresponding to the at least one first wireless communication signal received by the banking machine, to at least one server in operative connection with the banking machine through a wide area network.

These steps correspond to an automated banking machine such as an ATM that is capable of enabling wireless communication devices to access servers on the Internet through wireless

communication with the ATM. Joao is not directed to such a system. Nowhere does Joao disclose or suggest an automated banking machine capable of carrying out recited steps (a) and (b) of claim 6.

For example, referenced paragraph [0257] of Joao indicates that a central processing computer (303) may be linked with various communication devices (e.g., phone 307, pager 313) through a wired or wireless link (Figure 10). Referenced paragraph [0246] indicates that Joao may include an electronic cash transaction device (302) which is a terminal or other device used by an operator in performing transactions involving electronic cash. Referenced paragraph [0259] refers to Figure 11, and lists the various devices that are a part of the electronic cash transaction device (302) (e.g., CPU 302A, transmitter 302G, receiver 302H, etc.). Referenced paragraph [0053] indicates that Joao may be used in connection with the Internet.

These portions of Joao do not disclose or suggest an automated banking machine that is capable of carrying out steps (a) and (b) of claim 6. Further, the Action does not explain how these cited paragraphs correspond to the Appellants' recited steps. The Office apparently regards Joao's communication devices (e.g., phone 307, and pager 313) as corresponding to the recited "portable wireless device." However, the Action does not state which features of Joao allegedly correspond to Appellants' recited automated banking machine and recited server. Thus Appellants have been forced to speculate that the Office regards the electronic cash transaction device (302) as corresponding to an automated banking machine, and regards the central processing computer (303) as corresponding to a server.

However, regardless of whether the communication device, the electronic cash transaction device and the central processing computer of Joao could correspond respectively to a

portable wireless device, an automated banking machine, and a server; the referenced portions of Joao still do not disclose or suggest that the system of Joao carries out steps (a) and (b) as specifically recited in claim 6. Nowhere does Joao disclose or suggest computer readable media bearing instruction which are operative to cause a computer in Joao's electronic cash transaction device (or any other device/terminal 2, 102, 202, etc.) to receive a wireless communication signal from a communication device (e.g., wireless phone, pager) and then operate to send a network communication signal corresponding to the wireless communication signal, to Joao's central processing computer.

In addition, recited steps (a) and (b) are also not inherent in Joao. Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency, the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999).

Whether or not Joao discloses a wide area network as asserted in the Action, neither a wide area network nor any other feature in Joao requires or necessitates an automated banking machine to send a network communication signal to a server through a wide area network, which signal corresponds to a wireless communication signal received with the automated banking machine from a portable wireless device. Nowhere does Joao require or necessitate a portable

wireless device to communicate with an automated banking machine to facilitate communication over a wide area network. Thus the features explicitly recited in claim 6 are not inherent in Joao.

In addition, nowhere does Joao disclose or suggest an automated banking machine that sends to a server, a network communication signal that corresponds to a wireless communication signal from a portable wireless device, and as recited in steps (b) and (c), sends at least one second wireless communication signal to the portable wireless device corresponding to at least one second network communication signal received from the server. Nowhere does Joao disclose or suggest an ATM that enables a wireless portable device to communicate wirelessly with the ATM to facilitate two-way communication between the wireless portable device and a server on a wide area network.

Joao does not explicitly or inherently disclose or suggest each of the steps, features, and relationships recited in claim 6. Appellants respectfully submit that the 35 U.S.C. § 102(e) rejection of claim 6 should be reversed.

### **Claim 18**

Claim 18 is an independent claim directed to a method. The method includes a step (a) of providing, with an automated banking machine, a wireless network connection between a portable wireless device and the automated banking machine. The automated banking machine includes a cash dispenser. In addition, the method includes a step (b) of providing, with the automated banking machine, a network connection between the automated banking machine and a public wide area network. Also, the method includes a step (c) of determining with the automated banking machine that the portable wireless device is permitted to access the public



wide area network. Further, the method includes a step (d) that recites responsive to (c), providing with the automated banking machine, the portable wireless device with access to the public wide area network through the wireless network connection with the automated banking machine.

The Action asserts that Joao discloses each of these steps. Appellants respectfully disagree. Joao is directed to a system that automatically notifies users by telephone, pager, et cetera, that a transaction is being carried out with one of their accounts (e.g., credit card). The user may then authorize or cancel the transaction (Figures 3A-3C). With respect to claim 18, the Action references Figure 10 and paragraphs [0257], [0246], [0259], and [0053] of Joao to support the rejections. However, neither these portions, nor any other portions of Joao, disclose or suggest all of the features relationships and steps recited in claim 18.

For example, referenced paragraph [0257] of Joao indicates that a central processing computer (303) may be linked with various communication devices (e.g., phone 307, pager 313) through a wired or wireless link (Figure 10). Referenced paragraph [0246] indicates that Joao may include an electronic cash transaction device (302) which is a terminal or other device used by an operator in performing transactions involving electronic cash. Referenced paragraph [0259] refers to Figure 11, and lists the various devices that are a part of the electronic cash transaction device (302) (e.g., CPU 302A, transmitter 302G, receiver 302H, et cetera). Referenced paragraph [0053] indicates that Joao may be used in connection with the Internet.

Neither in these referenced portions of Joao nor anywhere else does Joao disclose or suggest an automated banking machine that is capable of carrying out step (a) of providing, with

an automated banking machine (that includes a cash dispenser), a wireless network connection between a portable wireless device and the automated banking machine.

In addition, nowhere in these referenced portions of Joao or anywhere else does Joao disclose or suggest step (c) of determining with the automated banking machine that the portable wireless device is permitted to access a public wide area through a network connection provided by the automated banking machine.

Further, nowhere in these referenced portions of Joao or anywhere else does Joao disclose or suggest step (d) of providing with the automated banking machine, the portable wireless device with access to the public wide area network through the wireless network connection with the automated banking machine.

Further, the Action does not explain how these referenced portions of Joao correspond to the Appellants' recited steps. The Office apparently regards Joao's communication devices (e.g., phone 307, and pager 313) as corresponding to the recited "portable wireless device." However, the Action does not state which features of Joao allegedly correspond to Appellants' recited automated banking machine and recited server. Thus Appellants have been forced to speculate that the Office regards the electronic cash transaction device (302) as corresponding to an automated banking machine, and regards the central processing computer (303) as corresponding to a server.

Claim 18 recites that the automated banking machine includes a cash dispenser. As admitted in the Action (with respect to claim 3), Joao does not disclose or suggest a cash dispenser. Thus, claim 18 should be allowable over Joao on this basis alone.

In addition, regardless of whether the communication device, the electronic cash transaction device, and the central processing computer of Joao could correspond respectively to a portable wireless device, an automated banking machine, and a server (which they do not), the referenced portions of Joao still do not disclose or suggest that the system of Joao carries out the method steps specifically recited in claim 18. Nowhere do the Action's referenced portions, or any other portion of Joao, disclose or suggest that Joao's electronic cash transaction device (or any other device/terminal 2, 102, 202, etc.) ever makes a determination that a portable wireless device is permitted to access the public wide area network. Further, nowhere do the Action's referenced portions or any other portion of Joao, disclose or suggest that Joao's electronic cash transaction device ever provides the portable wireless device with access to the public wide area network..

In addition, the method steps recited in claim 18 are also not inherent in Joao. Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency, the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999).

Whether or not Joao discloses a wide area network as asserted in the Action, neither a wide area network nor any other feature in Joao requires or necessitates an automated banking

machine to provide a portable wireless device with access to a public wide area network responsive to the automated banking machine determining that the portable wireless device is permitted to access the public wide area network. Joao's system can notify users by telephone, pager, et cetera, that a transaction is being carried out with one of their accounts without any need for an automated banking machine to provide a portable wireless device with access to a wide area network. Thus the recited steps are not inherent in Joao.

Joao does not explicitly or inherently disclose or suggest each of the steps, features, and relationships recited in claim 18. Appellants respectfully submit that the 35 U.S.C. § 102(e) rejection of claim 18 should be reversed.

## **The 35 U.S.C. § 103 (a) Rejections**

### **The Applicable Legal Standards**

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

#### **Rejection under 35 U.S.C. § 103(a) over Joao in view of Stewart**

Claims 7, 11, and 16-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao in view of Stewart. These rejections are respectfully traversed.

#### **Claim 7**

Claim 7 is an independent claim directed to an apparatus. The apparatus comprises an automated banking machine including a computer and a wireless access hub in operative connection with the computer. The Action acknowledges that Joao does not disclose a wireless access hub. However, to overcome the admitted deficiencies of Joao, the Action asserts that Stewart discloses a wireless hub (Figure 1) and that it would have been obvious to one with

ordinary skill in the art to include a wireless hub, because Stewart teaches that hub access is useful in business environment (Column 1, lines 26-43).

Appellants disagree. Stewart discloses wireless access points. However, nowhere does Stewart disclose or suggest that a wireless access point in operative connection with an automated banking machine computer.

Stewart discusses an Asynchronous Transfer Mode (acronym “ATM”) device (Column 6, line 12) which is a type of network technology. However, Asynchronous Transfer Mode network technology is not analogous to and does not suggest to one skilled in the art an Automated Teller Machine (also acronym “ATM”). Thus, nowhere in Stewart is there disclosed or suggested an automated banking machine such as an automated teller machine in operative connection with Stewart's wireless access points or a wireless access hub as recited in claim 7. Further, the Action has failed to show where Joao or Stewart or any other reference provides a prior art teaching, suggestion or motivation to modify Joao's electronic cash transaction device to include the wireless access point disclosed in Stewart. Neither Joao nor Stewart discloses or suggests any need for Joao's electronic cash transaction device to include a wireless access point.

Neither Joao nor Stewart discloses or suggests as recited in claim 7:

- wherein the wireless hub enables the [automated banking] machine to communicate with at least one portable wireless device.

Nowhere in Joao or Stewart is there disclosed or suggested an automated banking machine which communicates with a portable wireless device using a wireless access hub.

Also, neither reference discloses or suggests as recited in claim 7:

- wherein the machine is operative to enable the at least one portable wireless device to communicate in the wide area network.

Nowhere in Joao or Stewart is there disclosed or suggested an automated banking machine which enables communications between a portable wireless device and a wide area network.

Appellants respectfully submit that the Office has not established *prima facie* obviousness. Joao and Stewart do not disclose or suggest each and every feature and relationship of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Nor has the Office cited any other prior art which shows the features and relationships missing from Joao and Stewart. Nor is there any prior art teaching, suggestion, or motivation cited for modifying Joao in view of Stewart so as to produce the claimed invention. Further, it would not have been obvious to one having ordinary skill in the art to have modified Joao and Stewart to have produced the claimed invention. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 7 should be reversed.

#### **Claim 11**

Claim 11 depends from claim 7 and recites that the wide area network includes the Internet. Neither Joao nor Stewart discloses or suggests an automated banking machine which is operative to communicate with a portable wireless device and enable the portable wireless device to communicate in the Internet. Thus, the Office has not established *prima facie* obviousness with respect to claim 11. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 11 should be reversed.

### **Claim 16**

Claim 16 depends from claim 7 and recites that the wireless access hub is adapted to provide RF communication with the at least one portable wireless device. Neither Joao nor Stewart discloses or suggests an automated banking machine with a wireless access hub that is adapted to provide RF communication with a portable wireless device. Thus, the Office has not established *prima facie* obviousness with respect to claim 16. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 16 should be reversed.

### **Claim 17**

Claim 17 depends from claim 16 and recites that the wireless access hub enables RF communication over relatively short distance with the at least one portable wireless device.

Neither Joao nor Stewart discloses or suggests an automated banking machine with a wireless access hub that is adapted to provide RF communication over relatively short distance with a portable wireless device. Thus, the Office has not established *prima facie* obviousness with respect to claim 17. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 17 should be reversed.



**Rejection under 35 U.S.C. § 103(a) over Joao in view of Bansal**

Claims 5 and 13-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao in view of Bansal. These rejections are respectfully traversed.

**Claim 5**

Claim 5 depends from claim 4 and recites that the portable wireless device includes at least one memory including data representative of cash value, and claim 5 further recites modifying the data representative of cash value responsive to operation of the banking machine.

The Action admits that Joao does not disclose a portable wireless device that includes memory with modifiable cash value data. However, the Action asserts that Bansal discloses a portable wireless device that includes memory with modifiable cash value data at Column 3, lines 45-57. The Action also asserts that it would have been obvious to one with ordinary skill in the art to produce a portable wireless device that includes memory with modifiable cash value data because Bansal teaches (at Column 1, lines 21-41) cash transaction made by use of wireless devices is desired. Appellants respectfully disagree.

Bansal is directed to a method of transferring money from a cash card (102) inserted into a wireless phone (103) by making a telephone call using the phone (103) to another individual or entity. The information regarding the transfer can be transmitted from the user's wireless telephone using touch tones (Column 3, lines 33-41).

Although Bansal discusses transfers of money using a wireless phone, nowhere does Bansal disclose or suggest that its described phones ever communicate wirelessly with an

automated banking machine. Further, nowhere does Bansal disclose or suggest modifying data representative of cash value in a memory of a phone responsive to operation of an automated banking machine.

Neither Joao nor Bansal discloses or suggests an automated banking machine that receives at least one first wireless communication signal from a portable wireless device. Further, neither reference discloses or suggests sending through operation of the banking machine at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server in operative connection with the banking machine through a wide area network.

Thus, the Office has not established *prima facie* obviousness with respect to claim 5. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 5 should be reversed.

### **Claim 13**

Claim 13 depends from claim 7 and recites that the apparatus further comprises a portable wireless device including at least one data store, wherein the data store includes data representative of monetary value.

As admitted in the Action with respect to the rejection of claim 7, Joao does not disclose a wireless access hub. In addition, Bansal also does not disclose or suggest a wireless access hub. As claim 13 was only rejected in view of Joao and Bansal, and neither of these references discloses or suggests the wireless access hub recited in parent claim 7, the Office has not established *prima facie* obviousness with respect to claim 13.

Further, even if the Office applies a new ground of rejection against claim 13 which includes Stewart, Appellants respectfully submit that Joao, Bansal, and Stewart also do not disclose or suggest all of the features and relationships recited in claim 13. For example, nowhere do Joao, Bansal, and Stewart disclose or suggest an automated banking machine that is operative to enable a portable wireless device including a data store with monetary value data, to communicate in the wide area network.

Thus, the Office has not established *prima facie* obviousness with respect to claim 13. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 13 should be reversed.

#### **Claim 14**

Claim 14 depends from claim 13 and recites that the computer is operative to cause modification of the data representative of monetary value.

As admitted in the Action with respect to the rejection of claim 7, Joao does not disclose a wireless access hub. In addition, Bansal also does not disclose or suggest a wireless access hub. As claim 14 was only rejected in view of Joao and Bansal, and neither of these references discloses or suggests the wireless access hub recited in parent claim 7, the Office has not established *prima facie* obviousness with respect to claim 14.

Further, even if the Office applies a new ground of rejection against claim 14 which includes Stewart, Appellants respectfully submit that Joao, Bansal, and Stewart also do not disclose or suggest all of the features and relationships recited in claim 14. For example, nowhere do Joao, Bansal, and Stewart disclose or suggest a computer of an automated banking

machine which is operative to cause modification of data representative of monetary value included in a data store of a portable wireless device. Thus, the Office has not established *prima facie* obviousness with respect to claim 14. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 14 should be reversed.

### **Claim 15**

Claim 15 depends from claim 14 and recites that the portable wireless device comprises a voice communication device.

As admitted in the Action with respect to the rejection of claim 7, Joao does not disclose a wireless access hub. In addition, Bansal also does not disclose or suggest a wireless access hub. As claim 15 was only rejected in view of Joao and Bansal, and neither of these references discloses or suggests the wireless access hub recited in parent claim 7, the Office has not established *prima facie* obviousness with respect to claim 15.

Further, even if the Office applies a new ground of rejection against claim 15 which includes Stewart, Appellants respectfully submit that Joao, Bansal, and Stewart also do not disclose or suggest all of the features and relationships recited in claim 15. For example, nowhere does Joao, Bansal, and Stewart disclose or suggest a computer of an automated banking machine which is operative to cause modification of data representative of monetary value included in a data store of a portable wireless voice communication device. Thus, the Office has not established *prima facie* obviousness with respect to claim 15. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 15 should be reversed.

**Rejection under 35 U.S.C. § 103(a) over**  
**Joao in view of Laybourn**

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao in view of Laybourn. This rejection is respectfully traversed.

**Claim 2**

Claim 2 depends from claim 1 and recites that the method includes a step (e) of receiving through operation of the banking machine at least one third wireless communication signal from the portable wireless device. The at least one third wireless communication signal includes data representative of a financial account. In addition, the method includes a step (f) of validating through operation of the banking machine that the account is authorized to accept a charge of a usage fee. In addition, the method includes a step (g) of charging the usage fee to the account responsive to operation of the machine.

The Office admits that Joao does not disclose or suggest a usage fee or a fee charged responsive to a device enabled to communicate with a network. To overcome the admitted deficiencies in Joao, the Action asserts that Laybourn discloses a fee charged responsive to a device enabled to communicate with a network (Column 1, lines 18-25) and that it would have been obvious to one with ordinary skill in the art to include a fee charged responsive to a device enabled to communicate with a network because Laybourn teaches such is conventional in the wireless art (Column 1, lines 20-1). Appellants respectfully disagree.

Laybourn indicates that subscribers of wireless phone services pay a monthly subscriber fee for access to a wireless service (Column 1, lines 18-22). Laybourn does not disclose or suggest an automated banking machine and does not disclose or suggest wireless communication

between an automated banking machine and a portable wireless device. Also, as discussed previously, Joao does not disclose or suggest an automated banking machine which receives at least one first wireless communication signal from a portable wireless device. Thus, how can it be obvious to one with ordinary skill in the art to include subscriber fees for wireless phone service from Laybourn in an automated banking machine, when neither Joao nor Laybourn teaches or suggests any need for an automated banking machine to provide wireless services to a phone or any other portable wireless device?

Nowhere does the applied art disclose or suggest receiving, through operation of an automated banking machine, at least one third wireless communication signal from a portable wireless device, wherein the at least one third wireless communication signal includes data representative of a financial account. In addition, nowhere does the applied art disclose or suggest validating through operation of the automated banking machine that the account is authorized to accept a charge of a usage fee. In addition, nowhere does the applied art disclose or suggest charging the usage fee to the account responsive to operation of the machine.

Appellants respectfully submit that the Office has not established *prima facie* obviousness. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 2 should be reversed.

### **Claim 9**

Claim 9 depends from claim 7 and recites that the computer is adapted to receive information representative of an account from the at least one portable wireless device. In addition, claim 9 recites that responsive to the portable wireless device being enabled to

communicate in the wide area network, the computer is operative to cause a fee to be charged to each account.

As admitted in the Action with respect to the rejection of claim 7, Joao does not disclose a wireless access hub. In addition, Laybourn also does not disclose or suggest a wireless access hub. As claim 9 was only rejected in view of Joao and Laybourn, and neither of these references discloses or suggests the wireless access hub recited in parent claim 7, the Office has not established *prima facie* obviousness with respect to claim 9. Further, even if the Office applies a new ground of rejection against claim 9 which includes Stewart, Appellants respectfully submit that Joao, Laybourn, and Stewart also do not disclose or suggest all of the features and relationships recited in claim 9.

The Office admits that Joao does not disclose or suggest a usage fee or a fee charged responsive to a device enabled to communicate with a network. To overcome the admitted deficiencies in Joao, the Action asserts that Laybourn discloses a fee charged responsive to a device enabled to communicate with a network (Column 1, lines 18-25) and that it would have been obvious to one with ordinary skill in the art to include a fee charged responsive to a device enabled to communicate with a network because Laybourn teaches such is conventional in the wireless art (Column 1, lines 20-1). Appellants respectfully disagree.

Laybourn indicates that subscribers of wireless phone services pay a monthly subscriber fee for access to a wireless service (Column 1, lines 18-22). Laybourn does not disclose or suggest an automated banking machine and does not disclose or suggest wireless communication between an automated banking machine and a portable wireless device. Thus, how can it be obvious to one with ordinary skill in the art to include subscriber fees for wireless phone service

from Laybourn in an automated banking machine, when neither Joao nor Laybourn teaches or suggests any need for an automated banking machine to provide wireless services to a phone or any other portable wireless device?

The Action has failed to show where the applied art provides a prior art teaching, suggestion or motivation to modify an automated banking machine (or the electronic cash transaction device) to cause a fee to be charged to an account responsive to a portable wireless device being enabled to communicate in a wide area network. Further, nowhere does the applied art disclose or suggest a computer in an automated banking machine which is adapted to receive information representative of an account from the at least one portable wireless device.

Appellants respectfully submit that the Office has not established *prima facie* obviousness. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 9 should be reversed.

### **Claim 10**

Claim 10 depends from claim 9 and recites that the computer is adapted to communicate with a host banking system, wherein the computer is operative to cause the fee to be charged to the account through communication with the host banking system.

As admitted in the Action with respect to the rejection of claim 7, Joao does not disclose a wireless access hub. In addition, Laybourn also does not disclose or suggest a wireless access hub. As claim 10 was only rejected in view of Joao and Laybourn, and neither of these references discloses or suggests the wireless access hub recited in parent claim 7, the Office has not established *prima facie* obviousness with respect to claim 10. Further, even if the Office



applies a new ground of rejection against claim 10 which includes Stewart, Appellants respectfully submit that Joao, Laybourn, and Stewart also do not disclose or suggest all of the features and relationships recited in claim 10.

Joao, Laybourn and Stewart do not disclose or suggest that responsive to a portable wireless device being enabled to communicate in a wide area network, a computer of an automated banking machine is operative to cause a fee to be charged to an account through communication with a host banking system. Thus, the Office has not established *prima facie* obviousness with respect to claim 10. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 10 should be reversed.

#### **Claim 19**

Claim 19 depends from claim 18 and recites that the method includes a step (e) of receiving, with the automated banking machine, information corresponding to an account through the wireless network connection from the portable wireless device. In addition, the method includes a step (f) of causing, with the automated banking machine, a fee to be associated with the account for providing the portable wireless device with access to the public wide area network in (d).

The Office admits that Joao does not disclose or suggest a usage fee or a fee charged responsive to a device enabled to communicate with a network. To overcome the admitted deficiencies in Joao, the Action asserts that Laybourn discloses a fee charged responsive to a device enabled to communicate with a network (Column 1, lines 18-25) and that it would have

been obvious to one with ordinary skill in the art to include a fee charged responsive to a device enabled to communicate with a network because Laybourn teaches such is conventional in the wireless art (Column 1, lines 20-1). Appellants respectfully disagree.

Laybourn indicates that subscribers of wireless phone services pay a monthly subscriber fee for access to a wireless service (Column 1, lines 18-22). Laybourn does not disclose or suggest an automated banking machine and does not disclose or suggest wireless communication between an automated banking machine and a portable wireless device. Thus, how can it be obvious to one with ordinary skill in the art to include subscriber fees for wireless phone service from Laybourn in an automated banking machine, when neither Joao nor Laybourn teaches or suggests any need for an automated banking machine to provide wireless services to a phone or any other portable wireless device?

The Action has failed to show where the applied art provides a prior art teaching, suggestion or motivation to modify an automated banking machine (including a cash dispenser) to receive information corresponding to an account through a wireless network connection from a portable wireless device. In addition, the Action has failed to show where the applied art provides a prior art teaching, suggestion or motivation to modify an automated banking machine (including a cash dispenser) to cause a fee to be associated with the account for providing the portable wireless device with access to the public wide area network.

Appellants respectfully submit that the Office has not established *prima facie* obviousness. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 19 should be reversed.

### **Claim 20**

Claim 20 depends from claim 19 and recites that in step (d) the public wide area network includes the Internet.

The Action has failed to show where the applied art provides a prior art teaching, suggestion or motivation to modify an automated banking machine (including a cash dispenser) to receive information corresponding to an account through a wireless network connection from a portable wireless device. In addition, the Action has failed to show where the applied art provides a prior art teaching, suggestion or motivation to modify an automated banking machine (including a cash dispenser) to cause a fee to be associated with the account for providing the portable wireless device with access to the Internet.

Appellants respectfully submit that the Office has not established *prima facie* obviousness. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 20 should be reversed.

### **Rejection under 35 U.S.C. § 103(a) over Joao in view of Jones**

Claims 3, 8, and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao in view of Jones. This rejection is respectfully traversed.

### **Claim 3**

Claim 3 depends from claim 1 and recites that the method includes dispensing cash from the automated banking machine.

The Action admits that Joao does not disclose or suggest a cash dispenser of an automated banking machine that is responsive to input from a wireless device. However, the Action indicates that Jones discloses dispensing cash from an automated banking machine using a cash dispenser (Column 2, lines 42-46; Figure 1a) and that it would have been obvious to one with ordinary skill in the art to include a cash dispenser of Jones, because Joao teaches dispensing cash per se at paragraph [0189]. Appellants respectfully disagree.

Regardless of whether it would be obvious to include a cash dispenser in Joao in view of Jones (which it is not), neither Joao nor Jones discloses or suggests an automated banking machine that both dispenses cash and carries out steps (a) and (b) recited in claim 1. Nowhere does the applied art disclose or suggest an automated banking machine that dispenses cash and receives at least one first wireless communication signal from a portable wireless device. In addition, nowhere does the applied art disclose or suggest an automated banking machine that dispenses cash and sends at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server in operative connection with the banking machine through a wide area network.

Appellants respectfully submit that the Office has not established *prima facie* obviousness. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 3 should be reversed.

### **Claim 8**

Claim 8 depends from claim 1 and recites that the at least one transaction function device includes a cash dispenser.

As admitted in the Action with respect to the rejection of claim 7, Joao does not disclose a wireless access hub. In addition, Jones also does not disclose or suggest a wireless access hub. As claim 8 was only rejected in view of Joao and Jones, and neither of these references discloses or suggests the wireless access hub recited in parent claim 7, the Office has not established *prima facie* obviousness with respect to claim 8. Further, even if the Office applies a new ground of rejection against claim 8 which includes Stewart, Appellants respectfully submit that Joao, Jones, and Stewart also do not disclose or suggest all of the features and relationships recited in claim 8.

The Action admits that Joao does not disclose or suggest a cash dispenser from an automated banking machine that is responsive to input from a wireless device. However, the Action asserts that Jones discloses dispensing cash from an automated banking machine using a cash dispenser (Column 2, lines 42-46; Figure 1a) and that it would have been obvious to one with ordinary skill in the art to include a cash dispenser of Jones, because Joao teaches dispensing cash per se at paragraph [0189]. Appellants respectfully disagree.

Regardless of whether it would be obvious to include a cash dispenser in Joao in view of Jones, neither Joao nor Jones discloses or suggests an automated banking machine that is operative to both dispense cash and enable at least one portable wireless device to communicate in a wide area network. Appellants respectfully submit that the Office has not established *prima facie* obviousness. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 8 should be reversed.

## Claim 12

Claim 12 depends from claim 8 and recites that the computer is operative to cause cash to be dispensed by the cash dispenser responsive to at least one input to the at least one portable wireless device.

As admitted in the Action with respect to the rejection of claim 7, Joao does not disclose a wireless access hub. In addition, Jones also does not disclose or suggest a wireless access hub. As claim 8 was only rejected in view of Joao and Jones, and neither of these references discloses or suggests the wireless access hub recited in parent claim 7, the Office has not established *prima facie* obviousness with respect to claim 12. Further, even if the Office applies a new ground of rejection against claim 8 which includes Stewart, Appellants respectfully submit that Joao, Jones, and Stewart also do not disclose or suggest all of the features and relationships recited in claim 12.

For example, regardless of whether it would be obvious to include a cash dispenser in Joao in view of Jones as asserted in the Action (which it is not), neither Joao nor Jones discloses or suggests an automated banking machine that is operative to both enable at least one portable wireless device to communicate in a wide area network. and is operative to dispense cash responsive to at least one input to the at least one portable wireless device.

Appellants respectfully submit that the Office has not established *prima facie* obviousness. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 12 should be reversed.

## **The Nonstatutory Obviousness-Type Double Patenting Rejections**

### **Rejection on the ground of nonstatutory obviousness-type double patenting in view of the ‘181 patent**

Claims 1 and 18 were rejected under the ground of non-statutory obviousness-type double patenting over claims 1, 3, 5, 13-17, 18, 25-27 of the ‘181 patent. This rejection is respectfully traversed.

#### **Claim 1**

To support nonstatutory obviousness-type double patenting rejections, the Office bears the burden of showing: (A) the differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and (B) reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in a claim in the patent. MPEP § 804 (II)(B)(1).

There are numerous patentably significant differences between the claims in the present application and the claims in the referenced patent. The Action only compares the single element of “signals” with the element of “messages”. The Action has not established that all of the other features, relationships and steps recited in at least one claim of the present application, are disclosed or suggested by features in one claim of each of the referenced patents. For example, where are steps (a)-(d) of claim 1 disclosed or suggested by features recited in one claim in the ‘181 patent? They are not.

The Office has failed to establish that all of the elements, relationships, and steps recited in any claim of the application are obvious in view of any claim in the ‘181 patent. It follows that the nonstatutory obviousness-type double patenting rejection of claims 1 should be reversed.

### **Claim 18**

To support nonstatutory obviousness-type double patenting rejections, the Office bears the burden of showing: (A) the differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and (B) reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in a claim in the patent. MPEP § 804 (II)(B)(1).

There are numerous patentably significant differences between the claims in the present application and the claims in the referenced patent. The Action only compares the single element of “signals” with the element of “messages”. The Action has not established that all of the other features, relationships and steps recited in at least one claim of the present application, are disclosed or suggested by features in one claim of each of the referenced patents. For example, where are steps (a)-(d) of claim 18 disclosed or suggested by features recited in one claim in the ‘181 patent? Again, they are not.

The Office has failed to establish that all of the elements, relationships, and steps recited in any claim of the application are obvious in view of any claim in the ‘181 patent. It follows that the nonstatutory obviousness-type double patenting rejection of claims 18 should be reversed.



**Rejection on the ground of nonstatutory obviousness-type  
double patenting in view of Drummond**

Claims 1, 6, and 18 were rejected on the ground of non-statutory obviousness-type double patenting over claims 1, 6, 15, 19, 20-21 of Drummond. This rejection is respectfully traversed.

**Claim 1**

To support nonstatutory obviousness-type double patenting rejections the Office bears the burden of showing: (A) the differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and (B) reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in a claim in the patent. MPEP § 804 (II)(B)(1).

There are numerous patentably significant differences between the claims in the present application and the claims in the referenced patent. The Action only compares the single element of “signals” with the element of “messages”. The Action has not established that all of the other features, relationships and steps recited in at least one claim of the present application, are disclosed or suggested by features in one claim of each of the referenced patents. For example, where are steps (a)-(d) of claim 1 disclosed or suggested by features recited in one claim in the Drummond reference? They are not.

The Office has failed to establish that all of the elements, relationships, and steps recited in any claim of the application are obvious in view of any claim in Drummond. It follows that the nonstatutory obviousness-type double patenting rejection of claims 1 should be reversed.

### **Claim 6**

To support nonstatutory obviousness-type double patenting rejections the Office bears the burden of showing: (A) the differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and (B) reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in a claim in the patent. MPEP § 804 (II)(B)(1).

There are numerous patentably significant differences between the claims in the present application and the claims in the referenced patent. The Action only compares the single element of “signals” with the element of “messages”. The Action has not established that all of the other features, relationships and steps recited in at least one claim of the present application, are disclosed or suggested by features in one claim of each of the referenced patents. For example, where are steps (a)-(d) of claim 6 disclosed or suggested by features recited in one claim in the Drummond reference?

The Office has failed to establish that all of the elements, relationships, and steps recited in any claim of the application are obvious in view of any claim in the Drummond. It follows that the nonstatutory obviousness-type double patenting rejection of claims 6 should be reversed.

### **Claim 18**

To support nonstatutory obviousness-type double patenting rejections, the Office bears the burden of showing: (A) the differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and (B) reasons why a

person of ordinary skill in the art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in a claim in the patent. MPEP § 804 (II)(B)(1).

There are numerous patentably significant differences between the claims in the present application and the claims in the referenced patent. The Action only compares the single element of “signals” with the element of “messages”. The Action has not established that all of the other features, relationships and steps recited in at least one claim of the present application, are disclosed or suggested by features in one claim of each of the referenced patents. For example, where are steps (a)-(d) of claim 18 disclosed or suggested by features recited in one claim in the Drummond reference? Again, they are not.

The Office has failed to establish that all of the elements, relationships, and steps recited in any claim of the application are obvious in view of any claim in the Drummond. It follows that the nonstatutory obviousness-type double patenting rejection of claims 18 should be reversed.

**Rejection on the ground of nonstatutory obviousness-type  
double patenting in view of the ‘533 patent**

Claims 1 and 18 were rejected on the ground of non-statutory obviousness-type double patenting over claims 1, 5, 15, 17, and 21 of the '533 patent. This rejection is respectfully traversed.

**Claim 1**

To support nonstatutory obviousness-type double patenting rejections the Office bears the burden of showing: (A) the differences between the inventions defined by the conflicting claims

— a claim in the patent compared to a claim in the application; and (B) reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in a claim in the patent. MPEP § 804 (II)(B)(1).

There are numerous patentably significant differences between the claims in the present application and the claims in the referenced patent. The Action only compares the single element of “signals” with the element of “transmitted financial customer account number”. The Action has not established that all of the other features, relationships and steps recited in at least one claim of the present application, are disclosed or suggested by features in one claim of each of the referenced patents. For example, where are steps (a)-(d) of claim 1 disclosed or suggested by features recited in one claim in the ‘533 patent?

The Office has failed to establish that all of the elements, relationships, and steps recited in any claim of the application are obvious in view of any claim in the ‘533 patent. It follows that the nonstatutory obviousness-type double patenting rejection of claims 1 should be reversed.

### **Claim 18**

To support nonstatutory obviousness-type double patenting rejections the Office bears the burden of showing: (A) the differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and (B) reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in a claim in the patent. MPEP § 804 (II)(B)(1).

There are numerous patentably significant differences between the claims in the present application and the claims in the referenced patent. The Action only compares the single element

of “signals” with the element of “transmitted financial customer account number”. The Action has not established that all of the other features, relationships and steps recited in at least one claim of the present application, are disclosed or suggested by features in one claim of each of the referenced patents. For example, where are steps (a)-(d) of claim 18 disclosed or suggested by features recited in one claim in the ‘533 patent? They are not.

The Office has failed to establish that all of the elements, relationships, and steps recited in any claim of the application are obvious in view of any claim in the '533 patent. It follows that the nonstatutory obviousness-type double patenting rejection of claims 18 should be reversed.

## CONCLUSION

Each of Appellants' pending claims specifically recites elements, relationships, and steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for producing the recited invention. For these reasons it is respectfully submitted that the rejections of all the pending claims should be reversed.

Respectfully submitted,



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## CLAIMS APPENDIX

1. A method comprising:
  - a) receiving with an automated banking machine at least one first wireless communication signal from a portable wireless device;
  - b) sending through operation of the banking machine at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server in operative connection with the banking machine through a wide area network;
  - c) receiving through operation of the banking machine at least one second network communication signal from the at least one server; and
  - d) sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device corresponding to the at least one second network communication signal.
2. The method according to claim 1 further comprising:

- (e) receiving through operation of the banking machine at least one third wireless communication signal from the portable wireless device, wherein the at least one third wireless communication signal includes data representative of a financial account;
- (f) validating through operation of the banking machine that the account is authorized to accept a charge of a usage fee; and
- (g) charging the usage fee to the account responsive to operation of the machine.

3. The method according to claim 1 and further comprising:

dispensing cash from the automated banking machine.

4. The method according to claim 1 wherein the portable wireless device comprises a voice communication device.

5. The method according to claim 4 wherein the portable wireless device includes at least one memory including data representative of cash value, and further comprising modifying the data representative of cash value responsive to operation of the banking machine.



6. Computer readable media bearing instructions which are operative in at least one computer to cause the automated banking machine to carry out the method comprising:

- a) receiving with the automated banking machine at least one first wireless communication signal from a portable wireless device;
- b) sending through operation of the banking machine at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server in operative connection with the banking machine through a wide area network;
- c) receiving through operation of the banking machine at least one second network communication signal from the at least one server; and
- d) sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device corresponding to the at least one second network communication signal.

7. Apparatus comprising:

an automated banking machine including a computer;

at least one transaction function device in the machine and in operative connection with the computer; and

an external network interface in operative connection with the computer, wherein the external network interface enables the machine to communicate in a wide area network; and

a wireless access hub in operative connection with the computer, wherein the wireless hub enables the machine to communicate with at least one portable wireless device, wherein the machine is operative to enable the at least one portable wireless device to communicate in the wide area network.

8. The apparatus according to claim 7, wherein the at least one transaction function device includes a cash dispenser.

9. The apparatus according to claim 7, wherein the computer is adapted to receive information representative of an account from the at least one portable wireless device, and wherein responsive to the portable wireless device being enabled to communicate in the wide area network, the computer is operative to cause a fee to be charged to each account.

10. The apparatus according to claim 9, wherein the computer is adapted to communicate with a host banking system, wherein the computer is operative to cause the fee to be charged to the account through communication with the host banking system.

11. The apparatus according to claim 7 wherein the wide area network includes the Internet.

12. The apparatus according to claim 8 wherein the computer is operative to cause cash to be dispensed by the cash dispenser responsive to at least one input to the at least one portable wireless device.

13. The apparatus according to claim 7 and further comprising a portable wireless device including at least one data store, wherein the data store includes data representative of monetary value.

14. The apparatus according to claim 13 wherein the computer is operative to cause modification of the data representative of monetary value.

15. The apparatus according to claim 14 wherein the portable wireless device comprises a voice communication device.

16. The apparatus according to claim 7 wherein the wireless access hub is adapted to provide RF communication with the at least one portable wireless device.

17. The apparatus according to claim 16 wherein the wireless access hub enables RF communication over relatively short distance with the at least one portable wireless device.

18. A method comprising:

- a) providing, with an automated banking machine, a wireless network connection between a portable wireless device and the automated banking machine, wherein the automated banking machine includes a cash dispenser;
- b) providing, with the automated banking machine, a network connection between the automated banking machine and a public wide area network;
- c) determining with the automated banking machine that the portable wireless device is permitted to access the public wide area network;
- d) responsive to (c), providing with the automated banking machine, the portable wireless device with access to the public wide area network through the wireless network connection with the automated banking machine.

19. The method according to claim 18, further comprising:

- e) receiving, with the automated banking machine, information corresponding to an account through the wireless network connection from the portable wireless device;
- f) causing, with the automated banking machine, a fee to be associated with the account for providing the portable wireless device with access to the public wide area network in (d).

20. The method according to claim 19, wherein in (d) the public wide area network includes the Internet.

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## EVIDENCE APPENDIX

(none)

**(x)**

**RELATED PROCEEDINGS APPENDIX**

(None)